

## **REMARKS**

### **I. Introduction**

Claims 9, 11, 13, 14, 16 to 19, 21 and 22 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 9 and 13 Under 35 U.S.C. § 102(b)**

Claims 9 and 13 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,446,885 ("Sims, Jr. et al."). It is respectfully submitted that Sims, Jr. et al. does not anticipate these claims for at least the following reasons.

Claim 9 relates to a fuel injector for a fuel-injection system of an internal combustion engine, including: a solenoid coil; a tubular support acting as an inner pole of the solenoid coil; and a filter element affixed on an outer contour of the tubular support. The outer contour of the tubular support includes grooves. The tubular support includes a shoulder on a discharge side of the grooves. The shoulder extends radially outward beyond outer edges of the grooves.

Although Applicant does not necessarily agree with the merits of the rejection, to facilitate matters, claim 9 has been amended without prejudice to recite that **the filter element includes a glass fiber plastic extrusion coat**, that **the outer contour of the tubular support includes grooves having an undulating cross section**, and that **the filter element is configured to be affixed to the outer contour of the tubular support by radially compressing the glass fiber plastic extrusion coat of the filter element into the grooves**. In addition, claims 17 to 19 and 21 have been amended to conform to the changes made to claim 1.

Sims, Jr. et al. describes a fuel injector including a needle valve (34) having apertures (58), as well as a fuel filter screen (134) that covers the apertures (58) and filters fuel that passes through the apertures (58). However **Sims, Jr. et al. does not disclose, or even suggest, that a filter element includes a glass fiber plastic extrusion coat**. As indicated in column 4, lines 53 to 56 of Sims, Jr. et al., the filter (134) may be made from stainless steel or other suitable, chemically resistive materials, but no mention is made of the fuel filter screen (134) including a glass fiber plastic extrusion coat. In addition, **Sims, Jr. et al. does not disclose, or even suggest, that an outer contour of a tubular support includes grooves**

**having an undulating cross section.** As is apparent from column 3, lines 13 to 18 and column 4, lines 11 to 19 of Sims, Jr. et al., the needle valve (34), which the Office Action considers to constitute a tubular support, does not include grooves, but apertures (58), which allow fuel to travel from the bore (60) of the needle valve (34), through the fuel filter screen (134) and into the interior space of the jacket (14). Furthermore, **Sims, Jr. et al. does not disclose, or even suggest, that a filter element is configured to be affixed to the outer contour of a tubular support by radially compressing a glass fiber plastic extrusion coat of the filter element into grooves.** As set forth above, the fuel filter screen (134) does not include a glass fiber plastic extrusion coat, and the needle valve (34) does not include grooves. In addition, as is apparent from Figures 2 and 5 of Sims, Jr. et al., neither the body portion (138) nor the first and second edge portions (142) and (146) of the fuel filter screen (134) are radially compressed into the apertures (58) of the needle valve (34). Accordingly, it is respectfully submitted that Sims, Jr. et al. does not anticipate claim 9 or dependent claim 13 for at least these reasons.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 9, 11 and 13 to 22 Under 35 U.S.C. § 103(a)**

Claims 9, 11 and 13 to 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,335,863 ("DeGrace") and U.S. Patent No. 3,779,268 ("Conkling"). It is respectfully submitted that the combination of DeGrace and Conkling does not render these claims unpatentable for at least the following reasons.

As an initial matter, claims 15 and 20 were canceled without prejudice in an "Amendment Under 37 C.F.R. § 41.33" filed together with an "Appeal Brief Pursuant to 37 C.F.R. § 41.37," on June 29, 2009, thereby rendering moot the rejection with respect to these claims.<sup>1</sup>

Regarding claim 9, **neither DeGrace nor Conkling discloses, or even suggests, that a filter element includes a glass fiber plastic extrusion coat.** The fine mesh screen (38) of DeGrace, which the Office Action considers to

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<sup>1</sup> To the extent that the "Amendment Under § 41.33" has not been entered, claims 15 and 20 are canceled herein without prejudice.

constitute a filter element, is not said to include a glass fiber plastic extrusion coat. In addition, the cylindrical filter cap (42), filter (46) and nut (56) of Conkling, which the Office Action considers to constitute a filter element, are not said to include a glass fiber plastic extrusion coat. Furthermore, **neither DeGrace nor Conkling discloses, or even suggests, that an outer contour of a tubular support includes grooves having an undulating cross section.** On page 4, the Office Action admits that DeGrace does not disclose the above-mentioned feature. Regarding Conkling, the Office Action considers the annular extension (50) of the body portion (18) of the changeover valve (VI) to constitute a tubular support, and the threaded portion (58) to constitute grooves. However, as is apparent from Figure 2 of Conkling, the threads (58) situated on the annular extension (50) do not have an undulating cross section, but a zigzag or sawtoothed cross section. Moreover, **neither DeGrace nor Conkling discloses, or even suggests, that a filter element is configured to be affixed to the outer contour of a tubular support by radially compressing a glass fiber plastic extrusion coat of the filter element into grooves.** As set forth above, neither the fine mesh screen (38) of DeGrace nor the cylindrical filter cap (42), filter (46) or nut (56) of Conkling includes a glass fiber plastic extrusion coat. In addition, when the nut (56) of Conkling is screwed onto the threaded portion (58) of the annular extension (50), the gasket (52) is pressed against annular extension (50) by the flange portion (48) of the cylindrical filter cap (42), but nothing is radially compressed into the threads (58). Accordingly, it is respectfully submitted that the combination of DeGrace and Conkling does not render claim 9 unpatentable for at least these reasons.

Claim 22 includes features analogous to claim 9 and has been amended in a manner analogous to claim 9. Accordingly, it is respectfully submitted that the combination of DeGrace and Conkling does not render unpatentable claim 22 for at least the reasons set forth above.

As for claims 11, 13, 14, 16 to 19 and 21, which ultimately depend from claim 9 and therefore include all of the features of claim 9, it is respectfully submitted that the combination of DeGrace and Conkling does not render unpatentable these dependent claims for at least the reasons set forth above.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Conclusion**

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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